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EXAMINER

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2176

DATE MAILED: 07/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

1. This action is responsive to communications: Amendment, filed 04/14/2006.
2. Claims 16-20 and 22-35 are pending. Claim 16 is an independent claim. Claims 1-15 and 21 have been cancelled. Claims 24-35 have been newly added.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 16-19, 22, 23, 24, 25, and 27-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

In regard to independent claim 16, the combined limitations of claim 16 are non-statutory as not being tangibly embodied in a manner so as to be executable. The combined limitations of the claim do not require the use of hardware to implement the claimed methods and/or systems. For example, "*A method for editing a graphical image page amongst a collection of a plurality of graphical image pages...*" is non statutory, instead being directed to nonfunctional descriptive material, not capable of causing functional change in the computer (see *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, p. 52-54).

In regard to dependent claims 17-19, 22, and 23, said claims are rejected because they add nothing to render the claimed subject matter statutory.

In regard to independent claim 24, the combined limitations of claim 24 are non-statutory as not being tangibly embodied in a manner so as to be executable. The

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combined limitations of the claim do not require the use of hardware to implement the claimed methods and/or systems. For example, “*A method for generating a photo album page...*” is non statutory, instead being directed to nonfunctional descriptive material, not capable of causing functional change in the computer (see *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, p. 52-54). Further, although independent claim 24 recites a graphical user interface, claim 24 at best is directed toward software *per se*, and is therefore not directed to a computer readable medium encoded with a data structure defining structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, instead claiming non statutory subject matter (see *Interim Guidelines*, p. 52, par. 2).

In regard to dependent claims 25-35, said claims are rejected because they add nothing to render the claimed subject matter statutory.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 16-20 and 22-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Word 2000 (hereinafter “MS Word”), copyright 1983-**

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1999, Microsoft Corporation, in view of Fisher et al. (hereinafter "Fisher"), U.S.

Patent No. 6,771,801, issued August 2004.

7. For illustrative purposes, screen shots of Microsoft Word 2000, p. 1-15 are cited to clarify the following claim rejections.

Independent claim 16 cites: *A method for editing a graphical image page amongst a collection of a plurality of graphical image pages, comprising:*

displaying a first graphical image page from among the plurality of graphical image pages, said first graphical image page including at least one grouping of graphical image data, wherein each group of graphical image data can be individually modified;

upon receipt of a user command, automatically producing a second graphical image page based on said first graphical image page and displaying said second graphical image page along with said first graphical image page for comparison of said first graphical image page and said second graphical image page, each of said first and second graphical image pages capable of being independently modified;

MS Word teaches the use of templates which were used for generating user specified documents such as a photo album page (p. 4). MS Word teaches that templates can be created from existing documents, such as a user created table containing graphic images, compare to *producing a second graphical image page based on said first graphical image page*. MS Word teaches grouping images, i.e., drawing objects (p. 12), and that each group can be individually modified, as by the menu options on the Drawing toolbar. MS Word allows a user to modify both

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documents and templates and select pages. MS Word teaches a side by side display of document pages, i.e., menu options Window, Split.

receiving first user input that modifies part of either said first or second graphical image page, wherein said modification enables the user to contrast said first and second graphical image pages; and

receiving second user input that selects one of said first and second graphical image pages for inclusion in said plurality of graphical image pages..

While MS Word does not explicitly teach editing a graphical image page, Fisher teaches a method of generating a photo album page using a template and images supplied by a user (Col. 1, l. 48-Col. 2, l. 3). Both Fisher and MS Word are directed toward using templates to format digital media. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Fisher to MS Word, so that MS Word would have the benefit of a user editable photo album template that would adjust to the number of images supplied by a user (Fisher, Col. 1, l. 40-45; Col. 1, l. 65-Col. 2, l. 4).

Regarding dependent claim 17, While MS Word does not explicitly teach generating a photo album page, Fisher teaches a method of generating a photo album page using a template and images supplied by a user (Col. 1, l. 48-Col. 2, l. 3). Both Fisher and MS Word are directed toward using templates to format digital media. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Fisher to MS Word, so that MS Word would have the benefit of a user editable

photo album template that would adjust to the number of images supplied by a user (Fisher, Col. 1, l. 40-45; Col. 1, l. 65-Col. 2, l. 4).

Regarding dependent claims 18-21, MS Word teaches a grouping of graphical image data on a page including a background pattern and a layout configuration modifiable by a user. MS Word teaches selecting a background pattern using Format, Background menu options for both a selection of JPEG files that are represented by thumbnail images and a selection of Microsoft Word files that are represented by thumbnail images (p. 2, "Pattern" and "Picture" tab, p. 6). MS Word teaches assigning a solid, blend, texture, pattern, theme or mosaic to said photo album page. MS Word teaches grouping images, i.e., drawing objects (p. 12), and that each group can be individually modified.

Regarding dependent claim 22, MS Word teaches deleting a graphical image page, for example, by not saving a document when closing a window.

Regarding dependent claim 23, MS Word teaches a side by side display of document pages, i.e., menu options Window, Split.

Independent claim 24 cites: *A method for generating a photo album page, comprising:*

opening a photo album page;

assigning a background pattern to said photo album page;

MS Word teaches opening a page which can be used as a photo album, i.e., File, New to create a new document (p. 7). MS Word teaches assigning a background pattern to a page (p. 2) by selecting Format, Background menu options. MS Word teaches the

use of templates which were used for generating user specified documents such as a photo album page (p. 4). While MS Word does not explicitly teach generating a photo album page, Fisher teaches a method of generating a photo album page using a template and images supplied by a user (Col. 1, l. 48-Col. 2, l. 3). Both Fisher and MS Word are directed toward using templates to format digital media. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Fisher to MS Word, so that MS Word would have the benefit of a user editable photo album template that would adjust to the number of images supplied by a user (Fisher, Col. 1, l. 40-45; Col. 1, l. 65-Col. 2, l. 4).

Claim 24 also cites: *selecting a layout configuration for said photo album page, said layout configuration defining a number of photos to be included on said photo album page, size of said photos, and absolute and a relative positions between said group of photos on said photo album page, wherein said selecting is based on a graphical user interface that enables user navigation of a hierarchical organization of layout configurations based on a number of photos supported by the layout configurations; and*

placing a group of photos on said photo album page at locations defined by said layout configuration.

MS word teaches the creation of a table layout configuration, by selection of menu options Table, Insert, Table where a number of cells to contain photos, i.e., images, can be defined and relative position, i.e., AutoFit to contents option can be defined. Photos from a group, i.e., as in photos selected from file or from Microsoft Clip art, can be

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placed in the page at the locations defined within the table (p. 4-6). MS Word teaches relative and absolute positions between photos and defining the size of photos to be included on a page. While MS Word does not explicitly teach basing selection on a graphical user interface that enables user navigation of a hierarchical organization of layout configurations based on a number of photos supported by the layout configurations, Fisher teaches user navigation of a hierarchical organization of layout configurations based on a number of photos supported by the layout configurations (Col. 3, l. 56-Col. 4, l. 49; Col. 5, l. 30-Col. 6, l. 51). Both Fisher and MS Word are directed toward using templates to format digital media. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Fisher to MS Word, so that MS Word would have the benefit of a user editable photo album template that would adjust to the number of images supplied by a user (Fisher, Col. 1, l. 40-45; Col. 1, l. 65-Col. 2, l. 4).

Regarding dependent claim 25, MS Word teaches opening a page, i.e., a photo album page using Microsoft Word program components, i.e., File, New to create a new blank document (p. 7).

Regarding dependent claims 26-28, MS Word teaches selecting a background pattern using Format, Background menu options for both a selection of JPEG files that are represented by thumbnail images and a selection of Microsoft Word files that are represented by thumbnail images (p. 2, "Pattern" and "Picture" tab, p. 6). MS Word teaches assigning a solid, blend, texture, pattern, theme or mosaic to said photo album page.

Regarding dependent claims 29-31, MS Word teaches the use of templates, i.e.,

layout configurations that are represented by thumbnail images (p. 4); that includes placeholders for photo images, and that further defines one or more relative positions for text entries. For example, the brochure template contains text boxes where pictures could be inserted, and placeholders for photo images (p. 8-9).

Regarding dependent claims 32-34, MS Word teaches dragging and dropping, copying, pasting, grouping, and associating images on a page (p. 10-12).

Regarding dependent claim 35, MS Word teaches automatically adjusting dimensions of a frame border and a photo relative to each other, as in adjusting the border of a table containing pictures (p. 13, 14). Also see Table menu tab where a number of cells to contain photos, i.e., images, can be defined and relative position, i.e., AutoFit to contents option can be defined

Response to Arguments

8. Applicant's arguments filed 04/14/2006 have been fully considered but they are not persuasive. In regard to applicant's arguments of the rejections of claims 16-19, 22, and 23 under 35 U.S.C. 101, while applicant submits that a mental step test is an improper test for determining whether statutory subject matter exists, it is respectfully noted that the rejected claims remain non statutory under the *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, since they are directed to nonfunctional descriptive material, not capable of causing functional change

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in the computer (see *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, p. 52-54).

Claims 2, 5, 10, and 21 have been cancelled, rendering the rejections under 35 U.S.C. 112 moot.

Regarding the rejections of independent claim 16 and dependent claims 17-20, 22, and 23 under 35 U.S.C. 103(a), in response to applicant's argument that the references fail to show certain features of applicant's invention (Remarks, p. 6-7), it is noted that the features upon which applicant relies (i.e., distinct input and output types, Remarks, p. 7, par. 1-3) are not recited in the rejected claim(s), Claim 16. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In regard to applicant's argument that the MS Word Split command produces a second window in a side by side display, and that the second window is another view of the same document (Remarks, p. 7, par. 4), it is respectfully noted that applicant's description of the Split command is incorrect, since the Split command produces a side by side window display where other documents can be opened and edited, and does not therefore produce "another view of the same document".

In response to applicant's argument that the examiner has made no assertion that Fisher teaches a display that enables comparison of photo album pages and independent modification of those photo album pages (Remarks, p. 8, par. 1), applicant is referred to the cited portion of Fisher (Col. 1, l. 48-Col. 2, l. 3) used in the rejection on

p. 7 of the Office Action mailed 12/14/2005. Applicant is further referred to the portions of Fisher cited in the rejections of amended 16 and newly added claim 24, above.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amelia Rutledge whose telephone number is 571-272-7508. The examiner can normally be reached on Monday - Friday 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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AR


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